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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,719	01/25/2002	Stephen J. Garske	617.039US2	1562

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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,719

Applicant(s)

GARSKE, STEPHEN J.

Examiner

Mark S. Graham

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/16/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,9,11-14,20 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,9,11-13,20 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3, 8, 9, 11-14, 20, and 22-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 9, 11, 12, ~~20~~, 22, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd in view of Browne '018 (Browne).

Regarding claims 1, ~~9~~, ¹¹11, ¹²12, 22, 25²⁷, and 29 Boyd discloses the claimed device and method with the exception of also including a seam. However, as disclosed by Browne it is known in the art to use a one-piece seamless design to fashion a golf hole collar or "liner" for visibility purposes. Although Browne's liner is not for the purpose of actually lining the cup, (Browne's liner lines the hole above the cup) the teaching of the one piece design would have been applicable to the ordinarily skilled artisan considering Boyd and the art as a whole. In view of Browne the use of a one-piece seamless design in fashioning Boyd's liner would have been obvious to the ordinarily skilled artisan wishing to make Boyd's device easier to insert into the hole.

Boyd discloses the claimed device with the exception of the means by which the sleeve is made. However, extrusion is a commonly known method of making plastics and would obviously have been suitable for making Boyd's sleeve.

Claims 3, 13, 20, 23, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1, 9, 11, 12, 20, ~~22~~, 25, 27, and 29 above, and further in view of Hageman. The device of claims 3, 13, 20, 23, 26, and 30 is obviated for the reasons explained above with the exception of the smaller length of the cylinder and the ridge or

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lip. However, as disclosed by Hageman it is known in the art to employ these features when providing a cup liner. It would have been obvious to one of ordinary skill in the art to provide these two features with Boyd's liner as well to save on material and to better secure the liner in the cup respectively.

Claims 8, 24, and 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Crocker in view of Browne. Crocker discloses the claimed device with the exception of also including a seam. Crocker's slits d5 may be considered notches or lines of weakness. However, as disclosed by Browne it is known in the art to use a one-piece seamless design to fashion a golf hole collar or "liner" for visibility purposes. Although Browne's liner is not for the purpose of actually lining the cup, (Browne's liner lines the hole above the cup) the teaching of the one piece design would have been applicable to the ordinarily skilled artisan considering Crocker and the art as a whole. In view of Browne the use of a one-piece seamless design in fashioning Boyd's liner would have been obvious to the ordinarily skilled artisan wishing to make Boyd's device easier to insert into the hole.

Applicant's arguments with respect to claims 1-3, 8, 9, 11-14, 20, and 22-30 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's declaration and evidence of commercial success have been noted and carefully considered. The sales shown by the applicant are impressive but are only a part of the considerations which have to be weighed in trying to determine obviousness under 35 U.S.C. 103. Office policy is to follow *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966) in the consideration and determination of obviousness under 35 U.S.C. 103. Under *Graham* four factual inquiries enunciated therein form a background for determining obviousness as follows:

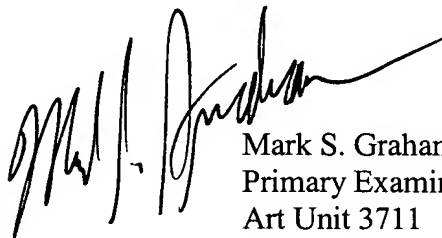
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- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

While applicant's submissions regarding commercial success (element D) have been given their full weight, the other three elements of Graham are, in the examiner's opinion, so persuasive as to obviousness, that the claimed invention cannot be considered unobvious.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

MSG
3/4/03



Mark S. Graham
Primary Examiner
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